

### REMARKS

Entry of the foregoing and reconsideration of the subject application are respectfully requested in light of the amendments above and the comments which follow.

Claims 1-21 are pending in this application. No claim amendments are submitted herewith in view of the below comments on the rejections.

### ***REJECTIONS UNDER 35 U.S.C. § 103***

Claims 1-21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,524,034 to Eng et al. (hereafter "*Eng*") in view U.S. Patent No. 7,455,482 to Lundvall (hereafter "*Lundvall*") on the grounds set forth at page 2 of the Official Action. Applicants respectfully traverse this rejection.

The rejection is improper because the *Lundvall* reference is not prior art to the present application for the following reasons.

First, this present application is a §371 application of PCT/SE05/00104 filed on January 28, 2005 designating the US and published in English. Thus, the US filing date is considered the PCT filing date and is January 28, 2005.

Turning to the Lundvall reference (USP 7,597,510)<sup>1</sup>, the *Lundvall* '510 reference was patented on Oct. 6, 2009, published on Nov. 8, 2007 and filed on July 10, 2007 with reference under 35 U.S.C. § 120 to the parent filing date of October 14, 2004 . The *Lundvall* '482

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<sup>1</sup> The Office Action applies USP 7,597,510 as the Lundvall reference as is clear from the PTO-892 listing and the reference to '510 in the Office Action. However, the *Lundvall* '510 reference is a continuation application, and the parent Lundvall reference (USP 7,455,482) will also be considered in this response and noted as *Lundvall* '482 herein.

reference was patented on Nov. 25, 2008, published on June 23, 2005 and filed on October 14, 2004. Both *Lundvall '510* and *Lundvall '482* are assigned to Sandvik Intellectual Property AB.

Comparing the filing date of the present application of January 28, 2005 to the various dates associated with the *Lundvall '510* and *Lundvall '482* references, it is clear that present application was filed before the publication date of either *Lundvall '510* and *Lundvall '482*, but after the earliest filing date of October 14, 2004. Therefore, both *Lundvall '510* and *Lundvall '482* are available as prior art to the present application only under 35 U.S.C. § 102(e).

However, use of either *Lundvall '510* or *Lundvall '482* in any obviousness-based rejection of Applicants' present claims is improper, because it is commonly assigned to the assignee of the present application.

Per MPEP §706.02(1)(2), the *Lundvall '510* or *Lundvall '482* patents can be removed as a reference by an affidavit or statement of common ownership at the time of the invention of the present application. Accordingly, Applicants provide the following statement:

U.S. Patent Application No. 10/587,749 and U.S. Patent No. 7,455,482 B2 and U.S. Patent No. 7,57,510 B2 were, at the time U.S. Patent Application No. 10/587,749 was made, owned by Sandvik AB.<sup>2</sup>

Since the *Lundvall '510* or *Lundvall '482* patents are no longer available as prior art against the application, Applicants respectfully request the withdrawal of this rejection.

Second, the date of invention of the present application based on a perfected priority date is prior to the date either of the *Lundvall '510* or *Lundvall '482* patents is available as prior art.

The PTO has previously acknowledged receipt of the priority document in this §371

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<sup>2</sup> For the noted patents and application, Sandvik AB is the predecessor in interest to the current assignee Sandvik Intellectual Property AB.

application in the Notice of Acceptance of Application dated August 27, 1007. Applicants submit herewith an English translation of the foreign priority document SE 0400183-0 filed in Sweden on January 30, 2004, with the purpose of perfecting the priority claim and overcoming the October 14, 2004 filing date of the *Lundvall* '510 or *Lundvall* '482 references. See MPEP §§ 201.13-15 and 706.02(b). The filing date of the foreign priority document antedates the *Lundvall* '510 and *Lundvall* '482 references, i.e., is before any of the filing date, date of publication of the application and date of issuance of the patent. Thus, the *Lundvall* '510 and *Lundvall* '482 references are not available as prior art to the present application and rejections based upon either of the *Lundvall* '510 or *Lundvall* '482 references are improper.

For at least the above reasons, Applicants respectfully request withdrawal of all rejections relying in whole or in part upon the the *Lundvall* '510 or *Lundvall* '482 references, e.g., the rejection of claims 1-21.

**CONCLUSION**

From the foregoing, further and favorable action in the form of a Notice of Allowance is earnestly solicited. Should the Examiner feel that any issues remain, it is requested that the undersigned be contacted so that any such issues may be adequately addressed and prosecution of the instant application expedited.

Respectfully submitted,

DRINKER, BIDDLE & REATH LLP

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By: 

Jeffrey G. Kilian  
Reg. No. 50,891

**CUSTOMER NO. 055694**  
**DRINKER, BIDDLE & REATH LLP**  
1500 K Street, N.W., Suite 1100  
Washington, D.C. 20005-1209  
Tel: (202) 842-8800 / F: (202) 842-8465